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IN THE

Supreme Court of the United States

JANUARY TERM, 1975

NO. 74-1041

SILVERLITH, INC.,
Petitioner
v.
AZOPLATE CORPORATION,
Respondent

REPLY TO OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

EUGENE F. BUELL
THOMAS L. SIVAK
301 Fifth Avenue Building
Pittsburgh, Pennsylvania 15222
Attorneys for Petitioner

DONALD A. GARDINER, JR.
GARDINER, SIXBEY, BRADFORD AND CARLSON
2001 Jefferson Davis Highway
Arlington, Virginia 22202

BLENKO, BUELL, ZIESENHEIM & BECK
301 Fifth Avenue Building
Pittsburgh, Pennsylvania 15222
Of Counsel

SMITH BROS., LAW PRINTERS, 620 SECOND AVENUE, PITTSBURGH, PA. 15219

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I

Petitioner, Silverlith, has just learned of the pending petition for certiorari to the Court of Appeals for the Second Circuit; No 74-1016; *Leonard R. Kahn v. Dynamics Corporation of America.* In that case the Second circuit held the patent invalid for the reasons, *inter alia,* that the applicant failed to disclose material facts of which he was aware and had materially misrepresented the content of prior art reference. In these respects, the *Kahn* and *Silverlith* cases are on all fours. In *Silverlith,* however, the plaintiff escaped the consequences of his fraud because of the "but for" test.

Kahn thus emphasizes the divergence in the lower courts and emphasizes the need for a definitive ruling by this Court (Petition p. 12).

II

Azoplate's Reply to the Petition is unfounded in or contrary to the Record in controlling respects:

(1) The misstatements to the Patent Office were neither "innocent" nor "inadvertent" (Reply pp. 9, 11, 13). There is nothing in the Record to support Azoplate's protestation of innocence. The District Court obviously deemed that the misstatements were deliberate but dismissed them from consideration solely because the "but for" rule (Appendix Vol. p. 36).

More important, however, is the fact that the lawyer's repeated admonition to his client to destroy the writings or remove them from the files "if litigation is later contemplated" (Petition pp. 6-7) *are themselves manifestations of conscious wrong-doing; United States v. American Tobacco Co.* (1911) 221 U.S. 106 at 182; C.F.; *General Excavator Co. v. Keystone Driller Co.* (C.A.6, 1932) 62 F.2d 48 at 50; *Hazel Atlas Co. v. Hartford-Empire Co.* (1944) 322 U.S. 238 at 246-7; *Precision Co. v. Automotive Co.* (1945) 324 U.S. 806 at 816-9.

The statement that the errant lawyer was unable to find anything "embarrassing" in his "destroy or remove" instructions (Reply p. 5) is an utter distortion. What Gilbert actually said in deposition was that he could not point to "anything specific" without having all the material before him, and time to review it in detail (App. 765-768).

(2) The French patent teaches an operable method, and being operable is fatal to the patent in suit.

Azoplate's assertion that the French patent does not teach an operable method is contrary to its own *ante litem motam* records (App. 132-3, Ex. Book Vol. 1, DX 5; Appendix Vol. pp. 90-1).

Azoplate's misrepresentation to the Patent Office in this regard went to the very heart of the Section 103 issue of obviousness before the Patent Office (Ex. Book Vol 3, DX 77 pp. 88-9 and 98-101).

Respectfully submitted,

EUGENE F. BUELL
THOMAS L. SIVAK
Attorneys for Petition

Donald A. Gardiner, Jr.
Of Counsel
April 2, 1975